

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Scott Miller **Confirmation No.: 8682**

Serial No. : 09/776,936 Examiner: Shailendra Kumar

Filed : December 22, 1998 Group Art Unit: 1621

Title : INHIBITION OF RAF KINASE USING SYMMETRICAL
AND UNSYMMETRICAL SUBSTITUTED DIPHENYL UREAS

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed on August 4, 2010, please consider the remarks.

The rejection of solvates, the only issue, is based on allegations in view of the reference by West, Solid State Chemistry and Its Applications, 358 & 365, 1988. Applicants submit that the Office Action has not met its burden in establishing a lack of enablement by relying on the disclosure of this reference.

A highly similar case was recently decided by the Board of Patent Appeals and Interferences, and is brought to the attention of the Examiner as guidance. In said case, i.e., *Ex parte Liu*, Appeal 2009-015302, solvates were rejected in view of the disclosure of West, *supra* (which is the same reference as used in the present case), and Vippagunta, Crystalline Solids, 48 Advanced Drug Delivery Review 3-26, 2001. In said case also, the disclosure did not have examples of solvate formation, yet the Board held that the Examiner has failed to carry the burden of establishing a lack of enablement. See, especially the discussion on pages 7-9 of the decision, which was mailed on September 17, 2010, in case 10/820,647.